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PATENT APPLICATION

ATTORNEY DOCKET NO. 10017364-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Curtis Gregory Kelsay

Confirmation No.: 5126

Application No.: 10/053,989

Examiner: Worku, Negussie

Filing Date: January 19, 2002

Group Art Unit: 2625

Title: Optical Scanning Apparatus Having Self-Propelled Light Bar Assembly

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 28, 2006

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month  
\$120

☐ 2nd Month  
\$450

☐ 3rd Month  
\$1020

☐ 4th Month  
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Signature: John S. Reid

Respectfully submitted,

Curtis Gregory Kelsay

By John S. Reid

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Date: July 22, 2006

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PATENT APPLICATION

Docket No.: 10017364-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND  
INTERFERENCES

In re application of:

Inventor(s): Curtis Gregory Kelsay  
Serial No.: 10/053,989  
Filed: January 19, 2002  
Title: Optical Scanning Apparatus Having Self-Propelled Light Bar Assembly  
Art Unit: 2625  
Examiner: Worku, Negussie  
Confirmation No.: 5126

Mail Stop APPEAL BRIEF – PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPEAL BRIEF

SIR OR MADAM:

This communication is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 28, 2006. This Appeal Brief is being filed under the provisions of 37 C.F.R. § 41.37. The filing fee for filing this Appeal Brief, as set forth in 37 C.F.R. § 41.20(b)(2), is included herewith as indicated on the attached Transmittal of Appeal Brief.

(Continued on next page.)

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Docket No. 10017364-1  
Appeal Brief

1. Real Party In Interest:

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

2. Related Appeals and Interferences:

There are no other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

3. Status of the Claims:

The following list provides the status of all the claims in the application:

Claim 1-7: rejected – currently on appeal;

Claim 8: cancelled;

Claims 9-25: rejected – currently on appeal;

Claims 26-28: cancelled;

Claims 29-32: rejected – currently on appeal.

4. Status of Amendments:

No amendments have been filed or entered subsequent to the final action.

5. Summary of Claimed Subject Matter:

The summary corresponds to independent claims 1, 11, 16, 23, and 29, which are the independent claims on appeal. Discussions about elements and recitations can be found at least at the cited locations in the specification and drawings.

Claim 1:

With respect to claim 1, which is the first independent claim on appeal, an optical scanning apparatus (100, 100A, 200, 300) includes a scanner body (102, 102A, 202, 302) and a self-propelled light bar assembly (110, 110A, 210, 310) supported within the scanner body, wherein the light bar assembly is movable relative to the scanner body. The term “self-propelled light bar assembly” means that the light bar assembly contains the drive source (i.e., the motive source which drives the light bar assembly relative to the scanner body). This is to be distinguished from the prior art scanner apparatus, wherein the motive source for the light bar is not supported by, or contained within, the light bar and its immediately supporting structure. (See specification at page 7, line 19, through page 16, line 32, and Figures 1-11.)

Claim 11:

With respect to claim 11, which is the second independent claim on appeal, an optical scanning apparatus (100, 100A, 200, 300) includes a scanner body (102, 102A, 202, 302) and a light bar assembly (110, 110A, 210, 310) supported within the scanner body, the light bar assembly comprising a drive motor (142) and a light source (118), the light bar assembly configured to move the drive motor and the light source together relative to the scanner body. (See specification at page 7, line 19, through page 16, line 32, and Figures 1-11.)

Claim 16:

With respect to claim 16, which is the third independent claim on appeal, an optical scanning apparatus (200) includes a scanner body (210), and a magnet-track portion (254) of a linear electric motor fixedly supported within the scanner body. The apparatus also includes a light bar assembly (210) that includes a slider portion (232) of a linear electric motor. Additionally, the light bar assembly is supported in the scanner body to place the magnet-track portion in proximity to the slider portion to thereby allow the light bar assembly to be driven along the magnet-track portion by interaction of the magnet track portion with the slider portion. (See specification at page 13, line 25 through page 16, line 32, and Figures 7-8.)

Claim 23:

With respect to claim 23, which is the fourth independent claim on appeal, a method of moving a light bar assembly (110, 110A, 210, 310) within a scanner body (102, 102A, 202, 302) of an optical scanning apparatus (100, 100A, 200, 300) that includes providing a stationary track (154, 154A, 254, 354) is described. The method includes providing a motive source (142, 232) supported by the light bar assembly, and moving the light bar assembly along the stationary track using the motive source. (See specification at page 16, line 33 through page 17, line 17.)

Claim 29:

With respect to claim 29, which is the fifth independent claim on appeal, a scanner (110, 110A, 210, 310) includes a light (118, 218, 318) configured to move linearly within the scanner, and a motor (142, 232) in fixed association with the light such that the light and the motor are moved together.

6. Grounds of Rejection to be Reviewed on Appeal:

(A). Whether claim 1 is indefinite under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

(B). Whether claims 1-4, 6, 11, 13, 15-16, 18-25, and 29-32 are anticipated under 35 U.S.C. 102 by U.S. Patent 4,908,717 to Natori.

(C). Whether claims 5, 7, 9, 10, 12, 14 and 17 are unpatentable under 35 U.S.C. 103 over Natori in view of well known prior art.

7. Argument:

(A) Rejection under 35 U.S.C. 112, second paragraph

The appellant argues against the rejection of claim 1 as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention under 35 U.S.C. 112, second paragraph, based on the following:

(i) Examiner has not established a prima facie case of indefiniteness

The appellant notes that “[i]n rejecting a claim under the second paragraph of 35 U.S.C. 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.” (*Ex parte Wu*, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989) (citing *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (C.C.P.A. 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (C.C.P.A. 1970).)

In other words, the examiner, in rejecting a claim under the second paragraph of 35 U.S.C. 112, bears the burden of showing that the proposed claim language is indefinite to one of ordinary skill in the art.

The appellant notes further that the basis and/or explanation of the rejection of claim 1 under the second paragraph of 35 U.S.C. 112 is limited to the following statement made by the examiner in the final action: “In particular claim 1, what contains the self-propelled light bar assembly, is not defined what the applicant intended to claim.” (Final action, mailed 02/07/2006, page 2, paragraph 2).

The appellant respectfully contends that: 1) not only has the examiner failed to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims; but also that, 2) it is nearly impossible to ascertain with any degree of certainty the meaning of the examiner’s statement.

*(Note: as is evident from the appellant’s reply to the final action, the appellant has previously attempted to obtain clarification of the examiner’s statement, but none has been provided. Specifically, the appellant expressly informed the examiner that the appellant was unable to determine from the examiner’s statement the reason for the rejection of claim 1 under the second paragraph of 35 U.S.C. 112. The appellant also pointed out to the examiner that because the rejection of claim 1 under 35 U.S.C. 112 was a new ground of rejection that was neither necessitated by applicant’s amendment of the claims (claim 1 has never been amended) nor based on information submitted in an information disclosure statement, that the finality of the final rejection was improper in accordance with MPEP 706.07(a), and that the appellant had a right to be apprised of the basis for the new rejection, and to present arguments against the new rejection. In*

response, the examiner merely maintained the finality of the final action and provided no additional explanation of the basis for the rejection.)

Thus, the appellant contends that the rejection of claim 1 under 35 U.S.C. 112, second paragraph, is improper because the examiner has not met the burden of establishing the required *prima facie* case of indefiniteness, as explained above.

(ii) Claim 1 meets the requirements of 35 U.S.C. 112, second paragraph

The appellant notes that there are two requirements for definiteness under 35 U.S.C. 112, second paragraph. The first requirement is that the claims must set forth the subject matter that the applicants regard as their invention. (MPEP 2171.) The second requirement is the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. (Id.)

A rejection based on the failure to satisfy the first requirement for definiteness is appropriate only where the applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. (MPEP 2172.) In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which the applicants regard as their invention. (Id.)

The appellant notes that there is no evidence showing that the appellant's invention is something different from what is defined by the claims.

The appellant concludes, therefore, that claim 1 meets the first requirement under 35 U.S.C. 112, second paragraph.

The appellant notes that the second requirement for definiteness is evaluated in the context of whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the art. (MPEP 2171.) In other words, the second requirement for definiteness is that one of ordinary skill in the art would understand what is claimed in light of the specification.

The appellant notes that claim 1 reads as follows:

Claim 1. An optical scanning apparatus comprising:

a scanner body; and

a self-propelled light bar assembly supported within the scanner body.

The appellant contends that the appellant's specification provides to one of ordinary skill in the art an abundant, if not exhaustive, description and explanation of the terms "optical scanning apparatus," "scanner body," and "self-propelled light bar assembly", as well as an explanation and description of how the self-propelled light bar assembly is supported within the scanner body.

The appellant further contends that such description and explanation would enable one of ordinary skill in the art to understand fully what is claimed in claim 1. That is, the appellant contends that scope of claim 1, in view of the appellant's specification, is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art, and that claim 1, therefore, meets the second requirement of 35 U.S.C. 112, second paragraph.

The appellant therefore asserts that claim 1 complies with 35 U.S.C. 112, second paragraph, because (i) the scope of the subject matter embraced by claim 1 is clear to one of ordinary skill in the art, and (ii) the appellant has not otherwise indicated that he intends the invention to be of a scope different from that defined in claim 1. Accordingly, the rejection of claim 1 as being indefinite under 35 U.S.C. 112, second paragraph should be removed.

#### (B) Rejection under 35 U.S.C. 102 over Natori

##### Claims 1-4 and 6

The appellant argues against the rejections of claims 1-4 and 6 under 35 U.S.C. 102 on the grounds that each and every element as set forth in the claims are not found, either expressly or inherently described, in the cited prior art reference and that the identical invention is not shown by the cited reference in as complete detail as is contained in the claims. (MPEP 2131.)

The appellant notes that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and that the identical invention must be shown in as complete detail as is contained in the claim. (MPEP 2131.)

The appellant notes further that each of claims 1-4 and 6 contain the following limitation: a self-propelled light bar assembly supported within the scanner body.



The examiner contends that Natori discloses this limitation (i.e., a self-propelled light bar assembly) as light source unit (10).

As the appellant has noted previously in the appellant's reply to the final action, a common definition of the term "self-propelled" is: containing within itself the means for its own propulsion. (Merriam-Webster Online Dictionary, <http://www.m-w.com/dictionary/self%20propelled>.) Thus, the plain meaning of the term "self-propelled light bar assembly" is a light bar assembly containing within itself the means for its own propulsion. This is consistent with the appellant's specification at page 9, line 21 through page 10, line 5, which states (in part):

The present invention provides for an optical scanning apparatus having a self-propelled light bar assembly, as will be more fully described below. By "self propelled" I mean that the light bar assembly contains the drive source (i.e., the motive source which drives the light bar assembly relative to the scanner body). This is to be distinguished from the prior art scanner apparatus, wherein the motive source for the light bar is not supported by, or contained within, the light bar and its immediately supporting structure.

(Emphasis added.)

The appellant notes that, while the light source unit (10) disclosed by Natori is movable (as are nearly all scanner light assemblies), it is not self-propelled, as is required by appellant's claims 1-4 and 6.

Moreover, not only does Natori fail to teach a self-propelled light bar assembly, but Natori expressly teaches that the light source unit (10) is not self-propelled.

Specifically, Natori teaches a scanner body (1) containing a light source unit (10) that is propelled by way of driving means (25), wherein the driving means is supported on the base frame (3). (See Natori, col. 4, line 39 through col. 5, line 45, figures 3-4.)

Moreover, it is clear from a study of figures 3 and 4 of Natori, along with the accompanying written description of Natori, that the disclosed mechanism for driving the light source unit (10) would not function as described unless the driving means (25) is, in fact, mounted on the stationary base frame (3), and that the driving means is stationary relative to the movable light source unit.

Furthermore, and perhaps most notably, the examiner expressly admits that the driving motor (24) is fixedly supported within the scanner body, while the light source

unit (10) is moveable. (Examiner's final action mailed 02/07/2006, last paragraph of page 6, bridging to top of page 7.)

Thus, Natori teaches a scanner having a light source unit (10) that is propelled by a driving means (25), wherein the driving means is **not** contained within the light source unit. Moreover, Natori teaches that the driving means (25) is stationary relative to the movable light source unit (10). (*Id.*, and see figures 3-4.)

Therefore, Natori discloses a scanner in which the light source unit (10) is not self-propelled because the driving means (25) for propelling the light source unit is **not contained within** the light source unit, but is instead supported on a stationary frame external to the light source unit.

The appellant concludes, therefore, that none of claims 1-4 or 6 is anticipated by Natori because each and every element as set forth in each of those claims is not found, either expressly or inherently described, in Natori, and because the identical invention is not shown by Natori in as complete detail as is contained in each of those claims.

#### Claims 11, 13 and 15

The appellant argues against the rejections of claims 11, 13 and 15 under 35 U.S.C. 102 on the grounds that each and every element as set forth in the claims are not found, either expressly or inherently described, in the cited prior art reference and that the identical invention is not shown by the cited reference in as complete detail as is contained in the claims.

As is noted above, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and that the identical invention must be shown in as complete detail as is contained in the claim. (MPEP 2131.)

The appellant notes that each of claims 11, 13 and 15 contain the following limitation:

a light bar assembly supported within the scanner body, the light bar assembly comprising a drive motor and a light source, the light bar assembly configured to move the drive motor and the light source together.

The examiner contends that Natori discloses this limitation by disclosing a light source unit (10) supported within a scanner body (1), and that the light source unit

comprises a drive motor (24), and that the light source unit (10) and the motor (24) are configured to move together.

Natori teaches that the motor (24) is included within the driving means (25). (Natori, col. 5, lines 29-40, figures 3-4). As is noted above, Natori also teaches and that  
5 the driving means (25) is mounted to the stationary base frame (3) and that the motor (24) is not movable with the light source unit (10), but is instead stationary relative to the light source unit.

Therefore, Natori does not disclose a light bar assembly supported within the scanner body, the light bar assembly comprising a drive motor and a light source, the  
10 light bar assembly configured to move the drive motor and the light source together, as is required by appellant's claims 11, 13 and 15. On the contrary, Natori discloses no more than a scanner having a light source unit (10) that includes a light emitting rod (11), wherein the light source unit is driven by a stationary driving means (25) that includes a motor (24), and wherein the driving means and motor are mounted to a  
15 stationary base frame (3), and wherein the driving means and motor are stationary relative to the light source unit.

The appellant concludes, therefore, that none of claims 11, 13 or 15 is anticipated by Natori because each and every element as set forth in each of those claims is not found, either expressly or inherently described, in Natori, and because the  
20 identical invention is not shown by Natori in as complete detail as is contained in each of those claims.

#### Claims 16 and 18-22

The appellant argues against the rejections of claims 16 and 18-22 under 35  
25 U.S.C. 102 on the grounds that each and every element as set forth in the claims are not found, either expressly or inherently described, in the cited prior art reference and that the identical invention is not shown by the cited reference in as complete detail as is contained in the claims.

As is noted above, a claim is anticipated only if each and every element as set  
30 forth in the claim is found, either expressly or inherently described, in a single prior art reference, and that the identical invention must be shown in as complete detail as is contained in the claim. (MPEP 2131.)

The appellant notes that each of claims 16 and 18-22 contain the following limitations:

a magnet-track portion of a linear electric motor fixedly supported within the scanner body; and

5        a light bar assembly comprising a slider portion of a linear electric motor; wherein the light bar assembly is supported in the scanner body to place the magnet-track portion in proximity to the slider portion to thereby allow the light bar assembly to be driven along the magnet-track portion.

10        The examiner contends that Natori discloses these limitations. However, the appellant contends that Natori, in fact, clearly does not disclose, either expressly or inherently, any portion and/or form of a linear electric motor.

On the contrary, Natori discloses only what appears to be a rotary electric motor (24), as is evident from the shape of the motor itself (cylindrical), as well as from the engagement of the motor (24) with the rotary gears (23). (Natori, figures 3-4.)

15        Moreover, and perhaps most notably, the examiner expressly admits that Natori does not, in fact, disclose a linear electric motor. (Examiner's final action mailed 02/07/2006, page 11, second paragraph.)

20        The appellant concludes, therefore, that none of claims 16 or 18-22 is anticipated by Natori because each and every element as set forth in each of those claims is not found, either expressly or inherently described, in Natori, and because the identical invention is not shown by Natori in as complete detail as is contained in each of those claims.

#### Claims 23-25

25        The appellant argues against the rejections of claims 23-25 under 35 U.S.C. 102 on the grounds that each and every element as set forth in the claims are not found, either expressly or inherently described, in the cited prior art reference and that the identical invention is not shown by the cited reference in as complete detail as is contained in the claims.

30        As is noted above, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and that the identical invention must be shown in as complete detail as is contained in the claim. (MPEP 2131.)

The appellant notes that each of claims 23-25 contain the following limitations:  
providing a stationary track within the scanner body;  
providing a motive source supported by the light bar assembly; and  
moving the light bar assembly along the stationary track using the motive source.

5 The examiner contends that Natori discloses these limitations. However, the appellant contends that that Natori, in fact, clearly does not disclose, either expressly or inherently, "providing a motive source supported by the light bar assembly", as is required by claims 23-25.

10 On the contrary, as discussed above, and as the examiner admits, Natori expressly teaches that the motive source (motor 24) is fixedly supported on the stationary base frame (3), while the light source unit (10) is movable.

15 The appellant concludes, therefore, that none of claims 23-25 is anticipated by Natori because each and every element as set forth in each of those claims is not found, either expressly or inherently described, in Natori, and because the identical invention is not shown by Natori in as complete detail as is contained in each of those claims.

#### Claims 29-32

20 The appellant argues against the rejections of claims 29-32 under 35 U.S.C. 102 on the grounds that each and every element as set forth in the claims are not found, either expressly or inherently described, in the cited prior art reference and that the identical invention is not shown by the cited reference in as complete detail as is contained in the claims.

25 As is noted above, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, and that the identical invention must be shown in as complete detail as is contained in the claim. (MPEP 2131.)

30 The appellant notes that each of claims 29-32 contains the following limitation:  
a motor in fixed association with the light source such that the light source and the motor are moved together.

The examiner contends that Natori discloses these limitations. However, the appellant contends that that Natori, in fact, clearly does not disclose, either expressly or

inherently, a motor in fixed association with the light source such that the light source and the motor are moved together, as is required by claims 29-32.

On the contrary, as discussed above and as the examiner admits as noted above, Natori expressly teaches that the motive source (motor 24) is fixedly supported  
5 on the stationary base frame (3), while the light source unit (10) is movable.

The appellant concludes, therefore, that none of claims 29-32 is anticipated by Natori because each and every element as set forth in each of those claims is not found, either expressly or inherently described, in Natori, and because the identical invention is not shown by Natori in as complete detail as is contained in each of  
10 those claims.

(C) Rejection of claims under 35 U.S.C. 103(a) over Natori in view of well known prior art

The appellant argues against the rejections under 35 U.S.C. 103(a) of claims 5,  
15 7, 9-10, 12, 14 and 17 as being unpatentable over Natori in view of well known prior art, on the grounds that the examiner has not established a prima facie case of obviousness.

The appellant notes that a prima facie case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the  
20 preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (37 CFR 1.56(b)(2)(ii).)

When more than one reference or source of prior art is required in establishing  
25 an obviousness rejection, "it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." (*In re Lahu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).)

Specifically, obviousness requires either that the references expressly or  
30 impliedly suggest the claimed invention, or that the examiner present a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the reference teachings. (*Id.*)

In support of the obviousness rejection of claims 5, 7, 9 and 10, the examiner states only the following: "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nagoshi (USP 4,634,261) [*sic; note: the appellant assumes examiner intended to cite Natori rather than Nagoshi*] to use the above indicated elements of claims 5, 7, 9, 10, 12, 14, and 17."

The appellant contends that the prior art teachings do not appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification, nor has the examiner presented a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the reference teachings.

The appellant notes further that a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. (*In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ 2d 1362, 1366 (Fed. Cir. 1997).) A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. (*In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).)

The appellant contends that a person of ordinary skill in the art, upon reading Natori, would be led in a direction divergent from the path that the appellant took. Specifically, one of ordinary skill in the art, upon reading Natori, would be led to use a conventional rotary motor as a motive source and to fixedly mount the motor on the stationary base frame of the scanner, and to use some sort of belt/cable/chain transmission system connected with the stationary motor to move the light source as taught by Natori. This is completely divergent from the path taken by the appellant.

The appellant notes further that "the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification ... [or, in other words] ... one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (*In re Fritch*, 23 USPQ 2d at 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).)

The appellant contends that, with respect to each of the obviousness rejections, the examiner has supported the obviousness rejections by simply asserting that the individual parts of the appellant's claimed invention existed individually in the prior art,

and that it would have therefore been obvious to combine those individual parts as claimed by the appellant.

The appellant further contends that this manner of supporting the obviousness rejections is evidence of the use by the examiner of impermissible hindsight reconstruction in making the obviousness rejections of the appellant's claims.

The appellant contends that, in view of the foregoing, the information provided by the examiner in support of the obviousness rejections of the respective claims does not compel a conclusion that the claims are unpatentable, and that the examiner has not established a *prima facie* case of obviousness.

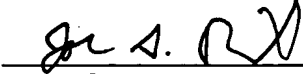
#### Summary

The appellant respectfully requests that the Board overturn the final rejections of claims 1-7, 9-25 and 29-32, and requests that those claims be allowed.

Dated this 22nd day of July, 2006.

Respectfully submitted,  
Curtis Gregory Kelsay (Appellant)

by

  
\_\_\_\_\_  
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8. Claims Appendix:

Claim 1. An optical scanning apparatus comprising:

a scanner body; and

a self-propelled light bar assembly supported within the scanner body.

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Claim 2. The optical scanning apparatus of claim 1, and further comprising a platen supported by the scanner body, and wherein the self-propelled light bar assembly comprises a drive wheel in contact with a drive track defined on the platen to allow the drive wheel to drive the light bar assembly along the platen.

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Claim 3. The optical scanning apparatus of claim 1, and further comprising a drive track supported within the scanner body, and wherein the self-propelled light bar assembly comprises a drive wheel in contact with the drive track to allow the drive wheel to propel the light bar assembly with respect to the scanner body.

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Claim 4. The optical scanning apparatus of claim 3, and further comprising a platen supported by the scanner body and having a first edge, and wherein the drive track is positioned adjacent to the first edge of the platen.

20 Claim 5. The optical scanning apparatus of claim 3, and wherein the light bar assembly comprises a biasing member configured to urge the drive wheel towards the drive track.

Claim 6. The optical scanning apparatus of claim 3, and wherein the light bar assembly is supported within the scanner body by the drive track.

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Claim 7. The optical scanning apparatus of claim 3, and wherein the drive wheel includes a rubberized outer portion, and the drive track has a non-smooth surface to allow the rubberized outer portion of the drive wheel to engage the drive track.

5 Claim 8 (canceled).

Claim 9. The optical scanning apparatus of claim 1, and wherein the light bar assembly comprises a rotary electric motor configured to propel the light bar assembly.

10 Claim 10. The optical scanning apparatus of claim 1, and wherein the light bar assembly comprises a linear electric motor configured to propel the light bar assembly.

Claim 11. An optical scanning apparatus comprising:

a scanner body;

15 a light bar assembly supported within the scanner body, the light bar assembly comprising a drive motor and a light source, the light bar assembly configured to move the drive motor and the light source together.

20 Claim 12. The optical scanning apparatus of claim 11, and wherein the scanner body defines an inside upper surface, and wherein the drive wheel contacts the inside upper surface of the scanner body.

25 (Continued on next page.)

Claim 13. The optical scanning apparatus of claim 12, and further comprising a support surface within the scanner body, upon which the light bar assembly is supported, and wherein the light bar assembly further comprises support wheels which rest on the support surface.

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Claim 14. The optical scanning apparatus of claim 13, and wherein the light bar assembly further comprises biasing members which support the support wheels on the light bar assembly, and wherein the biasing members urge the support wheels against the support surface, and thereby urge the drive wheel against the drive surface.

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Claim 15. The optical scanning apparatus of claim 11, and further comprising a position detecting system to allow the detection of the position of the light bar assembly with respect to the scanner body.

15 Claim 16. An optical scanning apparatus comprising:

a scanner body;

a magnet-track portion of a linear electric motor fixedly supported within the scanner body;

a light bar assembly comprising a slider portion of a linear electric motor; and

20 wherein the light bar assembly is supported in the scanner body to place the magnet-track portion in proximity to the slider portion to thereby allow the light bar assembly to be driven along the magnet-track portion.

Claim 17. The optical scanning apparatus of claim 16, and wherein the light bar  
25 assembly is suspended from the magnet-track portion.

Claim 18. The optical scanning apparatus of claim 16, and wherein the light bar assembly rests on top of the magnet-track portion.

Claim 19. The optical scanning apparatus of claim 16, and wherein the light bar assembly rests on a support surface defined within the scanner body such that the slider-portion and the magnetic-track portions are not in direct contact with one another.

Claim 20. The optical scanning apparatus of claim 16, and further comprising a position detecting system to allow the detection of the position of the light bar assembly with respect to the scanner body.

Claim 21. The optical scanning apparatus of claim 20, and wherein the position detecting system comprises:

a linear encoding strip supported within the scanner body and mounted parallel to the magnet-track portion; and

a sensor supported by the light bar assembly and configured to detect the linear encoding strip.

(Continued on next page.)

Claim 22. The optical scanning apparatus of claim 16, and wherein:

the light bar assembly is defined by a first end and a second end;

the magnet-track portion is a first magnet-track portion, the slider portion is a first slider portion, and the slider portion is supported proximate the first end of the light bar assembly;

the optical scanning apparatus further comprising:

a second magnet-track portion supported within the scanner body; and

a second slider portion supported proximate the second end of the light bar assembly and in contact with the second magnet track portion.

Claim 23. A method of moving a light bar assembly within a scanner body of an optical scanning apparatus comprising:

providing a stationary track within the scanner body;

providing a motive source supported by the light bar assembly; and

moving the light bar assembly along the stationary track using the motive source.

Claim 24. The method of claim 23, and wherein the light bar assembly is moved to a plurality of positions along the stationary track, the method further comprising determining the position of the light bar assembly as it is moved along the stationary track.

Claim 25. The method of claim 23, and further comprising urging the light bar assembly against the stationary track while moving the light bar assembly along the stationary track.

Claims 26-28 (canceled).

Claim 29. A scanner, comprising:

a light configured to move linearly within the scanner;

5 a motor in fixed association with the light source such that the light source and the motor are moved together.

Claim 30. The scanner of claim 29, further comprising a support member, the light and the motor fixedly attached to the support member, the support member movable within  
10 the scanner.

Claim 31. The scanner of claim 30, wherein the motor is configured to linearly move the support member within the scanner.

15 Claim 32. The scanner of claim 30, wherein the motor is connected to a drive wheel via a series of meshing gears, the drive wheel contacting a track within the scanner, the drive wheel carried by the support member.

20 -- End of Claims Appendix --

9. Evidence Appendix:

None.

10. Related Proceedings Appendix:

None.

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